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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,659	11/24/2003	Peter M. Simonson	5976-23CIP	6218

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EXAMINER

SWIGER III, JAMES L

ART UNIT PAPER NUMBER

3733

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/720,659

Applicant(s)

SIMONSON, PETER M.

Examiner

James L. Swiger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/8/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 7/20/2006 have been fully considered but they are not persuasive.

With regards to the arguments regarding the fact that all references directed to 35 U.S.C. 102 (b) including US Pat 5,409,488 (Ulrich), US Pat 5,486,174 (Fournet-Fayard), US Pat 5,554,157 (Errico) and US 5,634,925 (Urbanski) may be intended for facet joint fixation, however, all devices are capable in an unlocked state to provide movement and therefore support the facet joint while connected to the spinal area.

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over the above references where the device is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In light of the above statements, the following restrictions still apply.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ulrich (US Pat# 5409488). Ulrich discloses a spinal implant rod (1), connector (2) comprising a screw (5) and rod (1) connection member (2, 2', 14) having structure to engage the rod (3, 32) and screw (8), being pivotally engaged to the screw via the connection piece (2,2', Figure 1) where the screw may pivot (10) in one direction through the pivot opening (13) or rotate in another (column 4, lines 29- 65) and are therefore polyaxially pivoting, relative to the rod, where the pivot point is along the long axis of the screw. When the lock member (11) is not engaged, the screw is detachable from the connecting member. Connecting member 2' engages the rod with pins (34) to prevent sliding of the rod relative to the connector ( column 3, lines 25-29), an alternate connector (2) does not have these pins and allows for sliding of the rod. The opening (32) of the connection pies (2') comprises a saddle portion(32) for the rod end and a cap (4). Structure of the connector limits the angulations of connector relative to the screw, where the elastic spring ring member (28) being portion of a saddle for stop portion (11,12) of the screw and being a stop for the hexagon portion (12), also being a stop, on the screw and/ or connection portion where the elastic spring ring portion is capable of providing increasing resistance as angulations is increased. This particular device is comprised of one and two connectors (2), and two rod portions (1), each comprising a

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pivotally engaged screw (5, Figure 1) and being connected by a cross-linking member (2') for engaging both rods where the cross-linking member engages both rods and contacts both connection members through the rod and limits the movement of the rods, relative to the connectors, the rods being axially non displaceable (column3, line 16). The cross linking pins (34) bias the rods against changes in distance between the rods. The spinal rods follow the curvature of the spine, being parallel to it and span at least 3 vertebrae (column 1, lines 63-68) where the rods are adjustable (articulatable) in the sagittal plane (column 3, lines 17-22). The device of Ulrich is fully capable of the connection of adjacent vertebrae on the same lateral side of the spine, with a single rod (1), and multiple additional vertebrae (up to 3) with the use of both rods (1). When the screws are anchored to the spine and the connection portions 2) on each rod are not locked to the rod, the connector will be guided along the path of the rod as necessary due to the direction of bending of the spine, where the rod may then be locked to the connection element. If the screw is not locked to the connector with the locking sleeve (11) the connector is movable over the screw, where the screw is capable of providing a path for guiding the motion of the spine during a bend.

Claims 1-4, 6 and 15-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Fournet-Fayard (US pat# 5486174). Fournet-Fayard disclose a spinal rod (4b) and a pivotal rod connector (5j), polyaxially-pivotaly connected to, and over, the screw portion (5d,c), where the pivot point is along the long axis of the screw and the rod connecting disk (5j) is detachable from the screw and the rod is slidable relative to the connector (column 3, lines 4-8). Guidance means (5', Figure 6) is installed on the

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lower pedicle screws (3) and allows for pivotal movement with the sphere joint (5'h), where sliding motion can be fixed by the tightening of the nut (6), the device further includes the sliding connector (5) which allows for pivoting of the rod and sliding of the rod (all of column 3). The joint comprises a rod (4) substantially parallel to the spinal column, spanning at least 3 vertebrae (Figure 1) and is capable of articulating in the sagittal plane, via a side bend of the spine, the device connects adjacent vertebral bodies on the same side of the spine with a single rod. The rod (4) and screw (5 d,c) and joint (5j) are shaped and adapted to guide and provide a path during movement of the spine for "semi-rigid" sliding movement of the vertebrae (column 3, lines 5-8)

Claims 1,7 & 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Errico (US Pat# 5554157). Errico discloses a rod (190) with connection element (152) and a pivotally engaged screw (120) where the connector comprises a saddle (174) and a detachable cap for enclosing the rod (185), where the annular lip (163) that limits angulations of the screw.

Claims 1 & 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Urbanski (US Pat# 5634925). Urbanski discloses two spinal implant rods (Figure 1) with pivotal connectors for connection of the screw and the rods (Figure 3), further comprising a cross-link (Figure 1) for connection of the two rods, where the cross-link is capable of being in contact with the connector elements (as shown in the top of Figure 1). The cross-link member is inherently biased to preventing the change in the distance between the rods, as that is its main function.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

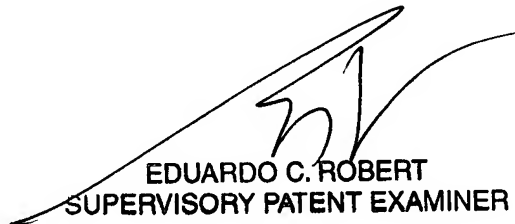
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



7/21/06

JLS



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